

## REMARKS

### I. Summary of the Examiner's Action

#### A. Claim Rejections

As set forth at page 14 of the March 27 Office Action, claims 13 – 14, 18 – 21 and 30 – 32 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

As set forth at page 15 of the March 27 Office Action, claims 1, 2, 11 – 15, 18 – 22 and 25 – 33 stand rejected under 35 U.S.C. § 102(b) as being anticipated by United States Patent No. 6,026,391 to Osborn *et al.* (hereinafter “the Osborn patent”).

As set forth at page 17 of the March 27 Office Action, claims 1, 2, 6 – 8, 11, 13, 18 – 20, 25, 26 and 29 – 33 stand rejected under 35 U.S.C. § 102(e) as being anticipated by United States Patent No. 6,847,938 to Moore (hereinafter “the Moore patent”).

As set forth at page 20 of the March 27 Office Action, claims 3, 4, 9, 10, 16, 17, 23 and 24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Moore patent.

As set forth at page 21 of the March 27 Office Action, claim 5 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the Moore patent as applied to claim 1, and further in view of United States Patent Application No. US 2002/0059258 to Kirkpatrick (hereinafter “the Kirkpatrick application”).

These rejections are respectfully disagreed with, and are traversed below.

II. Interview Summary

Applicants' Representative engaged in a telephonic interview with the Examiner of Record just after receipt of the March 27 Office Action; the interview occurred on or about March 30, 2006. After discussing the outstanding rejections it was agreed that amendments could possibly overcome the outstanding rejections, but the Examiner of Record would withhold judgment until such amendments were properly before him. Applicants' Representative indicated he would make his best efforts to place the case in condition for allowance by suitably amending the claims, but requested that the Examiner suggest further amendments if the Examiner still was not satisfied.

III. Applicants' Response - Rejection of Claims 13 – 14, 18 – 21  
and 30 - 32 under 35 U.S.C. § 101

Applicants have amended claims 13, 18, 20, 30 and 31. For example, Applicants have amended claim 13 to recite “providing the predictions to the users submitting later queries.” Applicants respectfully submit “providing the predictions to the users submitting later queries” is a “useful, concrete and tangible result” and thus satisfies the test set forth in *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 149 F3d 1368, 47 USPQ2d 1596, (Fed. Cir. 1998). In particular, in *State Street* the Federal Circuit stated:

“Transformations of data, representing discrete dollar amounts, by a machine through a series of mathematical calculations into a final share price,

constitutes a practical application of a mathematical algorithm, formula, or calculation, because it produces ‘a useful, concrete and tangible result’ – a final share price momentarily fixed for recording and reporting purposes and even accepted and relied upon by regulatory authorities and in subsequent trades.”

*State Street*, 149 F.3d at 1373, 47 USPQ2d at 1601. Applicants respectfully submit that this portion of the *State Street* decision aptly describes the processes now recited in claims 13, 18, 20, 30 and 31. In particular, the claims synonymously recite manipulating data to create processed information; momentarily fixing the processed information, and providing the processed information to users seeking it.

Accordingly, Applicants respectfully request that the Examiner withdraw the rejection of claims 13 – 14; 18 – 21 and 30 – 32 on this basis.

#### IV. Applicants’ Response – Prior Art Rejections

##### A. Applicants’ Invention

Applicants’ invention has numerous aspects several of which will be discussed here. This discussion is not meant to be a complete cataloguing of all aspects of Applicants’ invention; Applicants rely on the claims for establishing the metes and bounds of their invention.

In one aspect, Applicants’ invention comprises methods, systems and computer

program products that provide both performance prediction information and enhanced performance information. Performance prediction information is provided in response to performance queries submitted by users, and enhanced performance prediction information is provided in response to meta-queries submitted by users. Enhanced performance prediction information is derived from submitted performance queries. At least part of the enhanced performance prediction information is derived from information reflected in performance queries, such as information sought by the performance queries.

In another aspect, Applicants' invention comprises methods, systems and computer program products that use knowledge acquired in responding to performance queries that sought data relevant to the probability that a transaction with an entity of interest would be successful when predicting the future performance of the entity of interest.

B. Rejection of Claims 1, 2, 11 – 15, 18 – 22 and 25 - 33 under 35 U.S.C. § 102(b) over the Osborn patent

Claim 1, as amended, is reproduced here as a convenience to the Examiner:

1. A performance prediction system, comprising:  
at least one memory to store a plurality of computer program components,  
the computer program components further comprising:
  - a query component for receiving performance queries  
submitted by users for data relevant to the probability  
that transactions with entities of interest will be  
successful;
  - a data gathering component for deriving query-relevant data

from the submitted performance queries, where at least part of the query-relevant data is derived from information reflected in the performance queries; and for storing the query-relevant data;

a query fulfillment component for providing data relevant to the probability that transactions with entities of interest will be successful to the users submitting performance queries; and

a meta-query component for receiving meta-queries from users, wherein the meta-queries seek enhanced performance prediction information; for querying the stored query-relevant data to gather the enhanced performance prediction information, and for providing the enhanced performance prediction information to users submitting the meta-queries; and

at least one data processor to execute the computer program components.

Applicants respectfully submit that it is not seen where the subject matter of claim 1 is either described or suggested by the Osborn patent.

In particular, the Osborn patent describes a system where time estimates are provided to users submitting queries to a database. As described in Osborn, users are often provided with a pre-determined time in which to receive a response to a database query. If a database query submitted by a user exceeds the pre-determined time, no result is provided to the user.

In order to facilitate the decision about whether or not to perform the query, the method of Osborn estimates the amount of time to perform the query when the query is submitted. If the time estimate is greater than that allotted to the user, the user can decide not to continue with the processing of the query, since it would likely be dropped before it is finished.

It is noted that the time estimate is not directly responsive to the user's query. Rather, it is provided as part of an ancillary process unconcerned with what information the query actually seeks.

Applicants' invention does not operate in this manner; it is concerned with different subject matter. In particular, as recited in claim 1, it comprises, in part, "a query component for receiving performance queries submitted by users for data relevant to the probability that transactions with entities of interest will be successful". It is not seen how the Osborn patent meets this element since the information actually sought by the database queries is of interest to Osborn only for the purpose of estimating the amount of time it would take to perform the query. The actual information sought by the query in Osborn is immaterial since the query *might not even be performed*. Further, the Examiner should not be heard to state that the time estimate is what is sought by the user's query in Osborn. It would be illogical to accord Osborn's disclosure this interpretation, since it would essentially be saying that Osborn is estimating the amount of time it would take to perform a time estimate.

In addition, claim 1 additionally recites “a meta-query component for receiving meta-queries from users, wherein the meta-queries seek enhanced performance prediction information ...” It is not seen where the Osborn patent either describes or suggests this subject matter of claim 1. In particular, since Osborn does not disclose what the queries submitted by users seek, it is not seen how the Osborn patent can either describe or suggest “enhanced performance prediction information” which is derived from performance queries previously submitted by users. As a result, it is not seen where the Osborn patent either describes or suggests “providing the enhanced performance prediction information to users submitting the meta-queries” as required by claim 1.

Further, Applicants note that “performance queries” and “meta-queries” have been assigned distinctive meanings by Applicants and seek different categories of information. Even if the Examiner is correct that Osborn’s time estimates are returned in response to a query (Applicants propose this for the sake of argument and do not admit that the Examiner is correct), it is not seen how the Osborn patent can meet both the “query component” and “meta-query component” elements of claim 1. If the time estimate of Osborn is derived from information concerning prior database queries, at best the Osborn patent can only meet the “meta-query component” element of claim 1, since performance queries (handled by the query component) do not seek information derived from past queries.

Finally, as amended, claim 1 recites that “at least part of the query relevant data is derived from information reflected in the performance queries”. Notably, the time estimate in Osborn is not derived from information reflected in prior queries. The time estimate in Osborn is derived from the amount of time it took to perform prior queries.

For the foregoing reasons, Applicants respectfully submit that claim 1 is patentable over the Osborn patent. Applicants respectfully submit that claims 13, 18, 20, 29, 30, 31 and 33 are also patentable over the Osborn patent for reasons similar to claim 1 and for reasons attributable to their independently-recited features. Further, Applicants respectfully submit that dependent claims 2, 11 – 12, 14 – 15, 19, 21 and 32 are patentable over the Osborn patent both as depending from allowable base claims and for reasons attributable to their independently-recited features.

C. Rejection of Claims 1, 2, 6-8, 11, 13, 18 – 20, 25, 26 and 29 - 31 under 35 U.S.C. § 102(e) over the Moore patent

The Moore patent discloses a system for implementing a swap meet over the internet. In the system disclosed in Moore, users list items available for swap in an electronic database, identify items they would consider in exchange for their listed items, and a search engine identifies matches between items offered in exchange and items sought. Accordingly, the system disclosed in Moore is item-driven and not entity-driven as in the case of Applicants’ invention. Users in Moore are not concerned with receiving information predicting the performance of an entity of interest, rather, the users simply list the items they



have for exchange, and items they would accept in exchange.

As a result, it is not seen what relevance either the relied-upon portions or any other portion of the Moore patent have to the claims as amended. For example, claim 1 recites, in part, “a query component for receiving performance queries submitted by users for performance data relevant to the probability that a transaction with an entity of interest will be successful ...” Accordingly, a user of that aspect of Applicants’ invention as recited in claim 1 already has in mind an entity when the user submits a query to the system. The user is not seeking a business opportunity *per se* as is provided in Moore’s system when a match is identified. Rather, a user is seeking performance data that will help the user to decide whether to transact business with the entity of interest.

This is confirmed by closer examination of the disclosure of Moore. In Moore, users do not submit queries seeking performance data about an entity of interest; rather users simply identify items available for exchange, and items sought, as shown at Column 4, lines 21 - 31:

“In its preferred embodiment, the present invention takes advantage of the global presence of the internet by allowing users to interact with the system via an internet site. Although the characteristics and design of the internet site may vary widely, the site essentially provides input fields where users input information about the item they wish to trade, and information about the items they wish to acquire. The internet site can display other information including, but not limited to, the results of the system’s efforts to

arrange a satisfactory match, the status of a user account, and the availability of items for exchange.”

This portion of Moore confirms that users do not submit queries seeking performance data concerning an entity of interest; rather, the submissions of users in Moore simply identify items offered for exchange and items sought.

If there is any remaining doubt that the system of Moore is not concerned with providing “performance data relevant to the probability that a transaction with an entity of interest will be successful,” and is instead merely concerned with facilitating exchanges between parties regardless of identity, the following portion of Moore dispels it:

“The flowchart of FIG. 4, shows another embodiment of the present invention whereby the user is given the power to accept or reject matches generated by the system, shown in box 18. For example, assume a user inputs search criteria specifying that she would like to exchange her time-share in Hawaii for a time-share in the Caribbean. If a record is found in the database offering a timeshare in Jamaica, this will pass the test of box 10. Therefore, assuming box 11 is also passed, a match will be generated. According to the flowchart of FIG. 4, the user may be offered a choice of whether she accepts or declines the match. If she has already been to Jamaica and would prefer a time share on another Caribbean island, she may decline the match and choose to exchange time-shares with a different user. In that case, the system would proceed on through box 19 and continue searching.”  
[Moore patent, Column 9, lines 25 – 40]

Thus, it is not seen where “a query component for receiving queries submitted by users for

data relevant to the probability that a transaction with an entity of interest will be successful” as recited in claim 1 is either described or suggested by the Moore patent.

As discussed previously with respect to the Osborn patent, claim 1 additionally recites “a meta-query component for receiving meta-queries from users, wherein the meta-queries seek enhanced performance prediction information ...”. It is not seen how the Moore patent can meet this element of claim 1 since the information sought by meta-queries is derived from a type of query – a performance query – that the Moore system does not even receive! Even if it can be said that submitting an item available for exchange and an item sought constitutes a performance query, nowhere is there described in Moore a system allowing users to present meta-queries seeking information concerning previously submitted queries. In fact, nowhere is it either described or suggested that information derived from prior exchange activities as described in Moore can be accessed by a user through a query process:

“In another embodiment of the present invention, a more sophisticated and efficient artificial intelligence searching technique may be used wherein the system accumulates detailed user information regarding past transactions and areas of interest. This information can then be used by the system to track trends regarding individual users and broader categories of users. Trending information can be used to predict future transactions of interest to particular users. Such a system would result in more efficient user interaction because users can quickly be steered to transactions that are most likely to be of interest, or users may be automatically informed by the system of potential exchanges. For example, the system would receive information from a user and then, based upon user information and using artificial intelligence

techniques known in the art, the system can notify users that there has been a recent posting to the system that may be of interest.” [Moore, Column 7, line 59 – column 8, line 8]

It is simply not disclosed or suggested in this or any other passage of Moore that a user can submit a meta-query for enhanced performance prediction information as in Applicants’ claim 1. Instead, the *system* of Moore steers potential matches to users based on algorithms implemented in the system, and not in response to meta queries submitted by users.

The difference in operation between Applicants’ invention as claimed is made more evident by comparing the preceding portion reproduced from Moore with this portion of Applicants’ disclosure appearing at page 10, lines 15 - 24:

“Further examples of producing enhanced performance prediction information 135 include analysis of query relevant data 132 to produce, as examples only, information that is descriptive or indicative of: the number or received queries that are about a specific user (possibly during some prescribed period of time); about a specific product; queries that include or exclude an item of interest (such as an identity of a business or a competitor of the business); queries that are indicative of trends; a most often asked question received in queries, queries that are about reliability (product and/or business); queries relates to estimations of a success or failure of a transaction; and an average, a minimum, a maximum, and/or a count of queries containing a single (or multiple) specific subject(s).”

Moore simply does not make such information available to users.

As a result, Applicants respectfully submit that claim 1 is patentable over the Moore patent. Applicants therefore respectfully request that the rejection of claim 1 on this basis be withdrawn. Applicants also respectfully request that the rejection of claims 18, 29, 30, 31 and 33 be withdrawn for reasons similar to claim 1 and for reasons attributable to their independently-recited features.

Independent claim 13 recites a performance prediction service that performs the operation of “using knowledge acquired in responding to previously submitted queries which sought data relevant to the probability that a transaction with an entity of interest would be successful when making predictions concerning the future performance of the entity of interest . . .” The Moore patent simply neither describes nor suggests this subject matter. This is not surprising since the purpose of the Moore patent is to provide methods for facilitating exchanges between users; the users are not interested in the future performance of an entity of interest; the users are simply concerned with finding desired items to accept in exchange for items they possess. This applies equally to claim 20.

For the foregoing reasons, Applicants respectfully request that the rejection of claims 13 and 20 based on the Moore patent be withdrawn.

Applicants respectfully submit that dependent claims 2, 6 – 8, 11, 19 – 20, 25 – 26 and 32 are patentable over the Moore patent both as depending from independent claims that are

allowable for the foregoing reasons and for reasons attributable to their independently-recited features. Therefore Applicants request that the rejection of these claims based on the Moore patent be withdrawn as well.

D. Rejection of Claims 3, 4, 9, 10, 16, 17, 23 and 24 under U.S.C. § 103(a) over the Moore patent

Applicants respectfully reiterate their arguments regarding the lack of any disclosure in the Moore patent permitting users to access enhanced performance prediction information using meta-queries. As a result, it is not seen how the Moore patent can disclose particular instances of enhanced performance prediction information being returned to users in response to meta-queries as are recited in claims 3, 4, 9, 10, 16, 17, 23 and 24. Applicants therefore respectfully request that the rejection of claims 3, 4, 9, 10, 16, 17, 23 and 24 be withdrawn for this reason.

E. Rejection of Claim 5 under 35 U.S.C. § 103(a) over the Moore patent and Kirkpatrick application

Applicants respectfully submit that claim 5 is patentable as depending from a base claim that is allowable over the Moore for the foregoing reasons recited with respect to independent claim 1. Applicants therefore respectfully request that the Examiner withdraw the rejection of claim 5.

V. Conclusion

The Applicants submit that in light of the foregoing amendments and remarks the application is now in condition for allowance. Applicants therefore respectfully request that the outstanding rejections be withdrawn and that the case be passed to issuance.

Respectfully submitted,

June 27, 2006

Date

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